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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,392	11/12/2003	Kuniya Maruyama	MAKU 8814US	6840
1688	7590	08/24/2006	EXAMINER	
POLSTER, LIEDER, WOODRUFF & LUCCHESI 12412 POWERSCOURT DRIVE SUITE 200 ST. LOUIS, MO 63131-3615			REESE, DAVID C	
			ART UNIT	PAPER NUMBER
			3677	
DATE MAILED: 08/24/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/706,392	<b>Applicant(s)</b> MARUYAMA, KUNIYA	
	<b>Examiner</b> David C. Reese	<b>Art Unit</b> 3677	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 6-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 6-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

THIS FINAL ACTION IS RESPONSIVE TO THE AMENDMENT FILED 7/25/2006.

- Claims 4-5 were canceled.
- Claims 13-15 were added.
- Claims 1, 7-8, and 10 were amended.
- Claims 1-3 and 6-15 are pending.
- Drawing changes to Fig. 3 was filed for entry.

#### ***Drawings***

[1] The drawing(s) were previously objected for informalities. In view of Applicant's replacement drawing(s) submitted on 7/25/2006, all previous objection(s) to the drawings have been withdrawn. Accordingly, the replacement drawing has been entered.

#### ***Specification***

[2] The disclosure was previously objected to for informalities. Applicant has successfully addressed these issues in the amendment filed on 7/25/2006. Accordingly, the objection(s) to the specification (title) have been withdrawn, and the applicant's amendment to the specification (title) has been entered.

#### ***Claim Objections***

[3] Claim(s) 1 and 7-8 were previously objected to because of informalities. Applicant has successfully addressed these issues in the applicant's remarks filed on 7/25/2006. Accordingly, the objection(s) to the claim(s) 1 and 7-8 have been withdrawn.

However, as amended:

[4] Claim 13 is objected to because of the following informalities: "consisting of consisting essentially of" is not a proper transitional phrase.

Appropriate correction is required.

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[5] Claim 1 recites the limitation "the original" in the instant claim. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 112***

[6] Applicant has addressed all rejections under 35 USC § 112 to the Claims in the amendment filed 7/25/2006. Accordingly, the Examiner has withdrawn the previous 35 USC § 112 rejections.

***Claim Rejections - 35 USC § 103***

[7] The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

[8] Claims 1-3, and 6-15 are rejected under 35 U.S.C. 103(a) as clearly anticipated by West, US- 6,062,045, in view of case law.

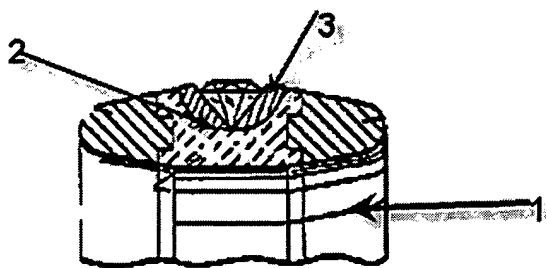
Although the invention is not identically disclosed or described as set forth 35 U.S.C. 102, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a designer having ordinary skill in the art to which said subject matter pertains, the invention is not patentable.

As for Claim 1, West teaches of an item of jewelry (see figure below) comprising a main body (1) having an inlay area (2) formed in said body (1), and a decorating part (3) secured in said inlay area (2); wherein the improvement comprises said decorating part (3) being composed

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of precious metal components (col. 6, lines 28, and from Claim 1, “a precious metal disposed within said groove”), [which naturally and uniformly changes color from a copper color to chocolate brown through oxidation and which can be polished back to recover the original color]; said decorating part (3) being secured in said inlay area (2) by a layer of solder (col. 6, line 30, “One way to affix precious metal to the part is to use a brazing process...”) in said inlay area (2) between said decorative part (3) and said main body (1).

Examiner’s note: the above statement in brackets is an example of intended use. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed; either through the user’s influence (polished back...) or through the natural process (naturally changing color...through oxidation) due to the chemical composition of the structure, does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).



The difference between the claim and West is that West does not expressly state that the composition of the decorative part (3) secured in the inlay area (2) of the main body (1) consists essentially of 6 to 15% copper and 94 to 85% gold. First, with regard to the applicant’s use of the terminology “consisting essentially of,” such statement has been recognized by the examiner, and as for the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103,

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absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, “consisting essentially of” will be construed as equivalent to “comprising.” It is apparent that the applicant is attempting to exclude any additional composition of material from the decorative part, but it is pertinent to point out that in the instant case the prior art of West is being used in conjunction with obviousness and that the exact percentages being used and/or claimed would fall under West in view of obviousness and case law, regardless of the use of the term, “consisting essentially of.”

Continuing, West states from part 5, beginning with line 61, of “a selected precious metal and/or other material installed in the groove 22...It will, of course, be appreciated that other forms of materials can be inlaid into the groove 22. For example, preformed metal, stone, ceramic, shell or other segments...Preferably, such items will be slightly recessed below the surfaces of the facets ...” Continuing, with part 6, line 32, “...that can be fabricated or forged into appropriate configurations and fit into the mating groove or channel 22. Fluxed or flux free gold or silver soldered compounds varying in color and purity between 50% and 99% can be applied on or around desired mating surfaces...” Continuing, with part 7, line 16 “...with the sculpted precious metal part 72 being mounted within a groove 74”.

Thus, as shown above, West does indeed teach of a precious metal, preformed metal, as well as other materials and their ability via a brazing process to be configured into the inlay (2) area. And though West does not give explicit percentages of materials, the examiner would like to point out that it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious engineering design choice. *In re Leshin*, 125 USPQ 416. It is also common knowledge to

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choose a material that has sufficient strength, durability, flexibility, hardness, and potential aesthetics (from applicant's disclosure on page 3, "...provides enjoyment"), etc, for the application, intended use, and design considerations of that material. Further, in addition, the examiner would also like to point out that such percentages as disclosed by applicant in the instant invention are merely the reverse of those percentages of Shakudo Jewelry, which is extremely well known in the art. Thus, it would also be readily understood and appreciated by those of ordinary skill in the art, of the known aptitude to combine varying percentages of different metals for purposes of obtaining different color schemes, and utilizing the different physical properties of each metal individually as well as the result combined, such as corrosion and hardness characteristics of a jewelry item.

Re: Claim 2, wherein said jewelry has a curved surface at said inlay area (2).

Re: Claim 3, wherein said jewelry is selected from a group of jewelry including rings (Fig. 2), pendants, necklaces, earrings, cuff buttons, brooches, tie tacks, bangles, buckles, chokers, bracelets, watch band and glasses.

Re: Claim 6, wherein said main body (1) is made of a metal chosen from the group consisting of a gold alloy, a silver alloy, a platinum alloy, and combinations thereof (col. 3, paragraph [0027, "and gold or alloys thereof").

Re: Claim 7, wherein said jewelry includes a flux applied to said main body (1) and/or said decorating part (3) (from col. 3, in paragraph [0033], "Fluxed or flux free gold or silver soldered compounds varying in color and purity between 50% and 99% purity can be applied on or around desired mating surfaces of the hard material"); said flux being applied to said main body (1) and/or decorating part (3) before said decorating part (3) is inserted in said inlay area

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(2) and before solder is ((continuing from paragraph [0033], “One way to affix precious metal to the part is to use a brazing process” (to solder (two pieces of metal) together using a hard solder with a high melting point)) placed about said decorating part (3) at a junction of said decorating part (3) and said main body (1); said layer of solder being [formed by applying heat to said item of jewelry; whereby, under heat, the flux evaporates forming a gap between said decorating item (3) and said main body (1) and said solder is pulled into said gap to form said layer of solder]

The determination of patentability in a product-by-process claim is based on the product itself, even though the claim may be limited and defined by the process. That is, the product in such a claim is unpatentable if it is the same as or obvious from the product of the prior art, even if the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985). A product-by-process limitation adds no patentable distinction to the claim, and is unpatentable if the claimed product is the same as a product of the prior art.

As for Claim 8, West teaches of an item of jewelry (see figure above) comprising a main body (1) having an inlay area (2) of concaved shape and a decorating part (3) secured in said inlay area (2); said inlay area (2) comprising a main channel (1/2) and at least one groove extending from a side of said channel (1/2); said decorating part (3) being comprised of a copper/gold alloy which contains 6 to 15 percent copper and 94 to 85 percent gold (see above remarks from claim 1) alloy [that naturally and uniformly changes color from a copper color to chocolate brown through oxidation, which can be polished back to recover the original color of the alloy], and which consists essentially of (see remarks from claim 1); said decorative part (3) being secured in said inlay area (2) said decorating part (3) corresponding in shape to the shape



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of the inlay area (2) main channel (1/2); said decorating part (3) being deformable to fill said at least one groove upon the application of pressure to said decorating part (3).

Examiner's note: the above statement in brackets is an example of intended use. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed; either through the user's influence (polished back...) or through the natural process (naturally changing color...through oxidation) due to the chemical composition of the structure, does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Re: Claim 9, wherein said at least one groove comprises at least a pair of oppositely positioned grooves (in view of Fig. 9), there being a first groove on a first side of said channel and a second groove on a second, opposite side of said channel; said first and second grooves of said pair of grooves being radially aligned with each other (in view of Fig. 9).

Re: Claim 10, wherein said main channel comprises two of said pairs of grooves; a first of said pairs of grooves main channel comprises two of said being proximate a bottom of said channel and a second of said pairs of grooves being positioned about midway up the height of said channel (It would have been obvious to one having ordinary skill in the art at the time the invention was made, to comprise any number of additional grooves, as it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art).

Re: Claim 11, wherein said grooves of said upper pair of grooves are shaped differently from the grooves of said lower pair of grooves (Note that those of ordinary skill in the art would appreciate that a modification such as a mere change in shape of a prior art device is a design

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consideration within the skill of the art. *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966)).

Re: Claim 12, wherein said grooves of said upper pair of grooves are generally trapezoidal in shape and the grooves of said lower pair of grooves are generally rectangular in shape (Note that those of ordinary skill in the art would appreciate that a modification such as a mere change in shape of a prior art device is a design consideration within the skill of the art. *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966)).

As for Claim 13, West teaches of a jewelry alloy composed of precious metal components (col. 6, lines 28, and from Claim 1, “a precious metal disposed within said groove”).

The difference between the claim and West is that West does not expressly state that the jewelry alloy consists essential of 6 to 15% copper and 94 to 85% gold. First, with regard to the applicant’s use of the terminology “consisting essentially of,” such statement has been recognized by the examiner, and as for the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, “consisting essentially of” will be construed as equivalent to “comprising.” It is apparent that the applicant is attempting to exclude any additional composition of material from the decorative part, but it is pertinent to point out that in the instant case the prior art of West is being used in conjunction with obviousness and that the exact percentages being used and/or claimed would fall under West in view of obviousness and case law, regardless of the use of the term, “consisting essentially of.”

Continuing, West states from part 5, beginning with line 61, of “a selected precious metal and/or other material installed in the groove 22...It will, of course, be appreciated that other

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forms of materials can be inlaid into the groove 22. For example, preformed metal, stone, ceramic, shell or other segments...Preferably, such items will be slightly recessed below the surfaces of the facets ...” Continuing, with part 6, line 32, “...that can be fabricated or forged into appropriate configurations and fit into the mating groove or channel 22. Fluxed or flux free gold or silver soldered compounds varying in color and purity between 50% and 99% can be applied on or around desired mating surfaces...” Continuing, with part 7, line 16 “...with the sculpted precious metal part 72 being mounted within a groove 74”.

And though West does not give explicit percentages of materials, the examiner would like to point out that it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious engineering design choice. *In re Leshin*, 125 USPQ 416. It is also common knowledge to choose a material that has sufficient strength, durability, flexibility, hardness, and potential aesthetics (from applicant’s disclosure on page 3, “...provides enjoyment”), etc, for the application, intended use, and design considerations of that material. Further, in addition, the examiner would also like to point out that such percentages as disclosed by applicant in the instant invention are merely the reverse of those percentages of Shakudo Jewelry, which is extremely well known in the art. Thus, it would also be readily understood and appreciated by those of ordinary skill in the art, of the known aptitude to combine varying percentages of different metals for purposes of obtaining different color schemes, and utilizing the different physical properties of each metal individually as well as the result combined, such as corrosion and hardness characteristics of a jewelry item.

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Re: Claim 14, West teaches wherein said alloy [that naturally and uniformly changes color from a copper color to chocolate brown through oxidation, which can be polished back to recover the original color of the alloy].

Examiner's note: the above statement in brackets is an example of intended use. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed; either through the user's influence (polished back...) or through the natural process (naturally changing color...through oxidation) due to the chemical composition of the structure, does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Re: Claim 15, West teaches wherein said alloy is a decorative part (3) of an item of jewelry, said decorative part (3) being inlaid (via 2) in a main body (1) of an item of jewelry.

### ***Response to Arguments***

[9] Applicant's arguments filed 7/25/2006 regarding rejections under 35 U.S.C. 103 have been fully considered but they are not persuasive. Applicant states that the applicant solves a substantially different problem than that of West, the examiner disagrees. The applicant, in the instant case, has simply provided varying percentages of both copper and gold together in an alloy, and due to their chemical properties, when combined at their varying percentages naturally (due to their chemical/physical formula) change color. This, however, provides no unexpected result that one skilled in the art of jewelry would not readily appreciate as a result of a combination of such materials. Applicant continues to argue that a prima facie case of obviousness has not been established. The examiner disagrees. It has been held that the test for obviousness is not whether the features of one reference may be bodily incorporated into the

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other to produce the claimed subject matter but simply what the combination of references makes obvious to one of ordinary skill in the pertinent art. *In re Bozek*, 163 USPQ 545 (CCPA 1969).

Further, it is not required that the prior art disclose or suggest the properties newly-discovered by an applicant in order for there to be a prima facie case of obviousness. See *In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897, 1905 (Fed. Cir. 1990). Moreover, as long as some motivation is provided by the prior art taken as a whole, the law does not require that the references be combined for the reasons contemplated by the inventor. See *In re Beattie*, 974 F.2d 1309, 24 USPQ2d 1040 (Fed. Cir. 1992); *In re Kronig*, 539 F.2d 1300, 190 USPQ 425 (CCPA 1976) and *In re Wilder*, 429 F.2d 447, 166 USPQ 545 (CCPA 1970). The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. *In re Keller*, 642 F. 2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In this regard, a conclusion of obviousness may be based on common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference. *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969).

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***Conclusion***

[10] Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


[11] Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Reese whose telephone number is (571) 272-7082. The examiner can normally be reached on 7:30 am-6:00 pm Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J.J. Swann can be reached at (571) 272-7075. The fax number for the organization where this application or proceeding is assigned is the following: (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David Reese  
Assistant Examiner  
Art Unit 3677

DCR



5/10/06



ROBERT J. SANDY  
PRIMARY EXAMINER